

DOCKET NO. MDFH01-00004  
U.S. SERIAL NO. 10/683,571  
PATENT

### REMARKS

Claims 2-20 were pending in this application.

Claims 2-20 are subject to a restriction requirement in view of previously cancelled Claim 1.

Claim 21 has been added.

Claims 2-21 are now pending in this application.

Reconsideration and full allowance of Claims 2-21 are respectfully requested.

#### **I. RESTRICTION REQUIREMENT**

The Office Action asserts that Claims 2-20 are directed to an invention that is "independent or distinct from the invention originally claimed." (*Office Action, Page 2, Section I*). Based on this, Claims 2-20 are subject to a restriction requirement in view of previously cancelled Claim 1.

The restriction of Claims 2-20 is improper.

First, 35 U.S.C. § 121 states that restriction is only appropriate in situations where "two or more independent and distinct inventions are claimed in one application." Similarly, 37 C.F.R. § 1.142 states that an applicant may be forced to elect claims for prosecution if "two or more independent and distinct inventions are claimed in a single application." In addition, when discussing the meanings of "independent" and "distinct," MPEP § 802.01 notes that these terms relate to the "inventions claimed" and the "inventions as claimed."

All of these authorities clearly state that a restriction is appropriate only when two or more independent and distinct inventions are "claimed" in the same application.

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Prior to this AMENDMENT AND RESPONSE, Claim 1 had been cancelled, and Claims 2-20 represented the only pending claims in this application. Because of this, Claim 1 does not represent a "claimed" invention in this application. As a result, Claim 1 cannot form the basis for restricting Claims 2-20.

Second, 37 C.F.R. § 1.145 states that if an applicant submits new claims after an office action, the applicant may be restricted to the previously claimed invention if the new claims are directed to "an invention distinct from and independent of" the previously claimed invention.

37 C.F.R. § 1.145 provides no basis for reviving a previously cancelled claim and forcing prosecution to continue with the previously cancelled claim. Rather, 37 C.F.R. § 1.145 simply indicates that restriction is appropriate and election occurs by default if an applicant submits new claims in addition to the original claims. The Patent Office previously entered an amendment cancelling Claim 1, and 37 C.F.R. § 1.145 cannot be used to revive Claim 1. As a result, there is no way that Claim 1 can be used as the basis for restricting any other claims in this application.

Moreover, the Patent Office makes no attempt to establish that Claims 2-20 are both "distinct" from and "independent" of Claim 1 as required by 37 C.F.R. § 1.145. Instead, the Office Action simply states that Claims 2-20 are independent "or" distinct from Claim 1. This is inadequate under 37 C.F.R. § 1.145, which requires a showing that Claims 2-20 are distinct from "and" independent of Claim 1.

In fact, the Patent Office cannot show that Claims 2-20 are distinct from "and" independent of Claim 1. Claim 1 previously recited "first and second mobile devices" that are operable to be monitored by a "communication network" as one mobile device or as separate mobile devices, as a

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function of a "relationship" between the mobile devices that is defined at least in part by a "threshold."

Claims 2 and 13 recite that a "central monitoring system" is capable of monitoring positions of "first and second mobile devices," where the first mobile device is capable of "transmitting to the central monitoring system first position information associated with the first mobile device" and "relaying to the central monitoring system second position information associated with the second mobile device." Claims depending from Claims 2 and 13 (such as Claims 3-5 and 14) recite that the first mobile device relays the second position information when "the second mobile device is within a threshold distance of the first mobile device."

Based on this, Claims 2-20 are related to original Claim 1 at a minimum. As a result, Claims 2-20 are not "independent" of Claim 1. (*MPEP* § 802.01). Because Claims 2-20 are not independent of Claim 1, the Office Action does not establish that Claims 2-20 are both "distinct from" and "independent of" Claim 1 as required by 37 C.F.R. § 1.145.

Accordingly, the Applicant respectfully requests withdrawal of the restriction requirement and examination of Claims 2-20.

## **II. COMPLETENESS OF OFFICE ACTION**

The Office Action dated August 30, 2005 represents an incomplete Office Action that should not be made final. The Office Action restricted Claims 2-20, asserting that original Claim 1 represents the elected invention. *MPEP* § 821.03 states that a "complete action on all claims to the elected invention should be given." Assuming (without admitting) that the Office Action properly

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restricted Claims 2-20, the Patent Office was required to provide a complete action as to original Claim 1.

Moreover, the Patent Office cannot assert that original Claim 1 was cancelled and therefore no action was required regarding Claim 1. The Patent Office cannot have it both ways. Claim 1 either represents (i) a cancelled claim that cannot form the basis of a restriction requirement, or (ii) the claim elected in response to the restriction requirement. The Office Action treats Claim 1 as the claim elected in response to the restriction requirement, so the Patent Office is required to provide a complete action as to original Claim 1. The Patent Office did not, so the Office Action dated August 30, 2005 is incomplete.

### III. NEW CLAIM

The Applicant has added new Claim 21. The Applicant respectfully submits that no new matter has been added. The Applicant respectfully requests entry and full allowance of Claim 21.

### IV. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

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**SUMMARY**

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@davismunck.com](mailto:wmunck@davismunck.com).

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date:

October 31, 2005

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